

Application No. 09/845,985

REMARKS

Claims 1-4, 6-21 and 48-54 are pending. By this Amendment, claim 5 is canceled and claim 1 is amended. Applicants would like to clarify that claims 22-47 have been canceled without prejudice in view of the restriction requirement. Also, new claims 48-54 are added. The specification has been amended to update references to copending applications that have subsequently issued. The amendment of claim 1 is supported by the specification, for example, at page 39, lines 7-8.

New claims 48-50 are supported by the specification, for example, at page 7, lines 17-21 and page 39, lines 6-29. New claims 51-53 are supported by the specification, for example, at page 37, line 12 to page 38, line 18. New claim 54 is supported by the specification, for example, at page 40, lines 5-8. No new matter is introduced by any of the amendments.

All of the pending claims stand rejected. Applicants respectfully request reconsideration of the rejection based on the following comments.

Drawings

The drawings were objected to for reasons noted on PTO-948. In response, formal drawings are attached.

Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 1-21 under 35 U.S.C. § 112, second paragraph as being indefinite. In particular, the Examiner asserted that the terms "greater than about" and "less than about" were self-contradictory. Applicants maintain that the claims are clear. Applicants respectfully request reconsideration of the rejection based on the following comments.

Application No. 09/845,985

Applicants note that when a continuous variable is recited as a whole number, there are clearly inherent approximations reflected in the number since a continuous variable is only measured with a certain precision. This inherent uncertainty has been recognized in the case law. In an interference context, a disclosure in a grandparent application of a nickel concentration from 45% to 55% was found to provide written description for "about 45% to about 55%" but not for the range of 50% to 60% that extended significantly beyond the limit in the grandparent application. Eiselstein v. Frank, 34 USPQ2d 1467, 1471 (Fed. Cir. 1995). Based on this realization, with all due respect, the Examiners' position that the terms "less than," "greater than," and "at least" specify a specific limit is not quite correct in the sense that the limit and the variable cannot exactly correspond. Specifically, the variable necessarily has a precision associated with it such that it never has an exact value separate from its precision.

Thus, Applicants maintain that the claims are clear to a person of ordinary skill in the art. Applicants respectfully request withdrawal of the rejection of claims 1-21 under 35 U.S.C. § 112, second paragraph as being indefinite.

Rejections Over Brown et al.

The Examiner rejected claims 1-4, 6 and 13-15 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,102,836 to Brown et al. (the Brown patent). The Examiner asserts that the Brown patent teaches crystalline phosphate powders with a submicron particle size. To advance prosecution of the application, Applicants have amended claim 1 to indicate that the crystalline composition comprises a lithium cation. The Brown patent does not disclose lithium compositions. Therefore, the Brown patent does not anticipate claim 1 or any claims depending from claim 1. With respect to the other aspects asserted in the Office Action regarding the Brown patent, Applicants do not comment on these other features since they are presently moot, although Applicants do not acquiesce in these assertions. Applicants respectfully request

Application No. 09/845,985

withdrawal of the rejection of claims 1-4, 6 and 13-15 under 35 U.S.C. § 102(b) as being anticipated by the Brown patent.

Rejection Over Matson et al.

The Examiner rejected claims 1-4 and 10-14 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,652,192 to Matson et al. (the Matson patent). The Examiner asserts that the Matson patent teaches submicron ferric phosphate particles. To advance prosecution of the application, Applicants have amended claim 1 to indicate that the phosphate compositions comprise lithium cations. The Matson patent does not disclose lithium-containing phosphates. Therefore, the Matson patent does not anticipate Applicants' claimed invention. While Applicants do not acquiesce in the assertions in the Office Action regarding particle size and particle size distributions, Applicants do not comment further on these issues here since they are presently moot. Applicants respectfully request withdrawal of the rejection of claims 1-4 and 10-14 under 35 U.S.C. § 102(b) as being anticipated by the Matson patent.

Rejections Over Kamauchi et al.

The Examiner rejected claims 1-6, 10, 16 and 19-21 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,538,814 to Kamauchi et al. (the Kamauchi patent). The Examiner asserts that the Kamauchi patent teaches submicron phosphate powders. With all due respect, the Kamauchi patent does not teach submicron phosphate powders and, thus, does not prima facie anticipate Applicants' claimed invention. Applicants respectfully request reconsideration based on the following comments.

"For a prior art reference to anticipate in terms of 35 U.S.C. § 102, every element of the claimed invention must be identically shown in a single reference. **These elements must be arranged as in the claim under review**, but this is not an 'ipsissimis verbis' test." In re

Application No. 09/845,985

Bond, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990)(Internal citations omitted and emphasis added.). "Every element of the claimed invention must be literally present, arranged as in the claim. **The identical invention must be shown in as complete detail as is contained in the patent claim.**" Richardson v. U.S. Suzuki Motor Corp., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)(Internal citations omitted, and emphasis added.); see also MPEP 2131. "Here, as well, anticipation is not shown by a prior art disclosure which is only 'substantially the same' as the claimed invention." Jamesbury Corp. v. Litton Industrial Products, Inc., 225 USPQ 253, 256 (Fed. Cir. 1985)(emphasis added).

With respect to claim 1 and claims depending from claim 1, Applicants note that claims 1-4 of the Kamauchi patent do not teach crystalline materials. Furthermore, at column 5, lines 30-36, only oxides are described and not phosphates with respect to particle size. Also, at column 6, lines 6-21, amorphous materials are described as being more desirable than crystalline materials. Thus, Applicants could not identify any description of submicron crystalline phosphates in the Kamauchi patent. Since the Kamauchi patent does not disclose submicron crystalline phosphate particles as taught and claimed by Applicants', the Kamauchi patent does not anticipate Applicants' claimed invention with respect to crystalline phosphate particles.

With respect to claim 21, as noted above, the specification at column 5, lines 30-36 only described formation of submicron oxides and not phosphates. According to claim 3, the average particle size of a combination of lithium phosphate, lithium-cobalt phosphate, cobalt oxide and lithium-cobalt oxide is 0.01 to 20 microns. Since the oxides can have a particle size less than a micron according to the specification, it does not follow that the phosphates necessarily have a particle size less than a micron. Certainly, it does not follow from the teachings of the Kamauchi patent that amorphous phosphate particles can have an average particle size less than about 95 nanometers. Thus, the Kamauchi patent does not prima facie anticipate Applicants' claim 21.

Application No. 09/845,985

Applicants respectfully request withdrawal of the rejection of claims 1-6, 10, 16 and 19-21 under 35 U.S.C. § 102(b) as being anticipated by the Kamauchi patent.

Rejections Over Goodenough et al. and Kamauchi et al.

The Examiner rejected claims 6-9 and 17-18 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,910,382 to Goodenough et al. (the Goodenough patent) and further in view of the Kamauchi patent. The Examiner cited the Goodenough patent for teaching  $\text{LiFePO}_4$  and  $\text{LiFe}_{1-x}\text{Mn}_x\text{PO}_4$ , where  $x$  is between 0 and 1, for use in lithium secondary batteries. ~~While the Examiner noted that the Goodenough patent did not disclose the claimed particle sizes,~~ the Examiner cited to Kamauchi patent for disclosing the claimed particle sizes. However, Applicants maintain that neither patent teaches submicron crystalline phosphate particles. Thus, the combined disclosures of the Goodenough patent and the Kamauchi patent do not render Applicants' claimed prima facie obvious. Applicants respectfully request reconsideration of the rejection based on the following comments.

Applicants noted above that the Kamauchi patent did not teach submicron crystalline phosphate particles. The Examiner has noted that the Goodenough patent does not disclose the particle sizes claimed by Applicants. Since neither the Goodenough patent nor the Kamauchi patent teach or suggest submicron crystalline phosphate particles, the combined disclosures of the Goodenough patent and the Kamauchi patent do not render Applicants' claimed invention prima facie obvious. Applicants do not comment on other features of the Goodenough patent cited in the Office Action since they are presently moot, although Applicants do not acquiesce in the assertions. Applicants respectfully request withdrawal of the rejection of claims 6-9 and 17-18 under 35 U.S.C. § 103(a) as being unpatentable over the Goodenough patent and further in view of the Kamauchi patent.

Application No. 09/845,985

## CONCLUSIONS

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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